

REMARKS

Favorable reconsideration of this application in light of the following discussion is respectfully requested.

Claims 1-20 are presently active in this case.

In the outstanding Official Action, Claims 1, 2, 5-8, and 11-20 were rejected under 35 U.S.C. 103(a) as being unpatentable over Otomo (U.S. Patent No. 5,943,954) in view of Schwöpfinger (U.S. Patent No. 5,320,042) and further in view of Marentes et al. (U.S. Patent No. 5,488,467). Claims 3, 4, 9, and 10 were rejected under 35 U.S.C. 103(a) as being unpatentable over Otomo in view of Schwöpfinger and Marentes et al. and further in view of Kon (JP 58002146A). For the reasons discussed below, the Applicants request the withdrawal of the obviousness rejections.

The basic requirements for establishing a *prima facie* case of obviousness as set forth in MPEP 2143 include (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, (2) there must be a reasonable expectation of success, and (3) the reference (or references when combined) must teach or suggest all of the claim limitations. The Applicants submit that a *prima facie* case of obviousness has not been established in the present case because there is no suggestion or motivation to modify or combine the references to arrive at the present invention.

Claim 1 of the present application recites a duplex stencil printer comprising, among other features, a cam member and a registration roller pair including a first roller disposed on

a lever and a second roller provided with a highly oil-repellent surface, where the second roller is configured to contact a surface of the recording medium that is opposite to a surface of the recording medium that contacts a print drum during a pass of the recording medium through the printer. Claim 8 recites a duplex stencil printer comprising, among other features, a first roller of a registration roller pair is provided with a highly oil-repellent surface, and a second roller of the registration roller pair is configured to contact a surface of the recording medium that is opposite to a surface of the recording medium that contacts a print drum during a pass of the recording medium through the printer. Claim 20 recites a duplex stencil printer comprising, among other features, first and second rollers to deliver the recording medium to a pressing member, where the second roller is configured to contact a surface of the recording medium that is opposite to a surface of the recording medium that contacts a print drum during a pass of the recording medium through the printer.

The Otomo reference describes a stencil printer that is selectively operable in a simplex print mode or a duplex print mode and includes two drums. The drums each have a respective master support on its circumferential surface. In the duplex print mode, the master supports contact each other with the intermediary of a paper so as to print images on both sides of the paper at the same time.

The Official Action cites first drum (79) of the Otomo reference as the print drum of the present invention, second drum (80) as the pressing means, pick-up roller (25) as the feeding means, and registration roller pair (30) as the plurality of conveying members. The Official Action acknowledges that the Otomo reference does not disclose that one of the

rollers of the registration roller pair (30) is provided with a highly oil-repellent surface or a with a surface configured to prevent adherence of the image to the roller, as is recited in the claims of the present application. The Official Action cites the Schwöpfinger reference for the teaching of a roller surface provided with an oil-repellent material or with a surface configured to prevent adherence of the image to the roller. However, the Applicants respectfully submit that one of ordinary skill in the art would not have had a motivation to modify or replace a roller of the registration roller pair (30) of the Otomo reference with such roller as taught in the Schwöpfinger reference, since the Otomo reference does not require such a specialized roller at the location of the registration roller pair for the reasons discussed below and thus there is no motivation for doing so absent hindsight.

The Otomo references describes in the Background of the Invention section that “[t]he current trend in the stencil printers art is toward duplex printing, i.e., printing images on both sides of a paper in order to reduce the consumption of papers. It has been customary to effect duplex printing by feeding a paper from a paper feeding section to a printing section, printing an image on one side of the paper, turning the paper upside down, and again feeding the paper to the printing section in order to print an image on the other side of the paper.” (Column 1, lines 23-30.) Such a type of duplex printer is described in the present invention. However, the Otomo reference directly teaches away from such a type of duplex printer, by stating that such duplex printing processes have three specific problems. One of the problems noted is that the ink on the papers or printings is not sufficiently dry just after the printing operation, and therefore images printed on the first side of the paper can be smeared

or distorted when the paper is again passed through the printer for printing on the second side of the paper. Thus, the Otomo reference teaches away from such a duplex printing process.

Instead, the Otomo reference specifically states that “[i]t is therefore an object of the present invention to provide a stencil printer capable of producing a duplex printing of desirable quality in a single step without producing any noise, and capable of producing a simplex printing also.” (Column 1, line 66, through column 2, line 2.) Therefore, in the invention of the Otomo reference, the piece of paper only travels through the printer once. During that single trip through the printer, the first drum (79) is used to form an image on a first side of the paper and the second drum (80) is used to simultaneously form an image on a second side of the paper. Therefore, a wet image on the paper never contacts the registration roller pair (30), and thus there is no need to make a surface of either of the rollers of the registration roller pair (30) with an oil-repellent material or with a surface configured to prevent adherence of the image to the roller. The Official Action suggests on page 2 that in the Otomo reference “the recording medium carrying an image on one surface thereof is reversed and again fed by the feeding means,” however the Otomo reference does not discuss any reversal of the direction of the recording medium and therefore no image will contact either roller of the registration roller pair (30). The Otomo reference is specifically designed to print images on both sides of the paper at the same time, as is noted in the Abstract and the Summary of the Invention, and thus there is no need for the type of roller described in the Schwöpfinger reference, absent hindsight considerations.

The Schwöpfinger reference is cited for the teaching of a roller surface provided with

an oil-repellent material. The Schwöpfinger reference describes a paper web guide roller used to guide a freshly printed paper web. However, the Schwöpfinger reference does not describe the use of such a roller as a registration roller for a print drum. Such a use would not be suggested by the combination of the Otomo reference and the Schwöpfinger reference, since there would be no suggestion or need to use an oil-repellant material on a roller of the registration roller pair (30), since the registration roller pair (30) does not guide freshly printed paper web because it is upstream of the printing and no reversing of the paper is discussed. Thus, based on the combination of the Otomo reference and the Schwöpfinger reference, there is no teaching or suggestion of a registration roller provided with a highly oil-repellent surface, absent hindsight reconstruction of the present invention.

Furthermore, the Marentes et al. reference is cited for the teaching of a cam and lever configuration. However, the Marentes et al. reference also does not teach a registration roller provided with a highly oil-repellent surface. Thus, the combination of the Otomo reference, the Schwöpfinger reference, and the Marentes et al. reference does not teach or suggest a registration roller provided with a highly oil-repellent surface, absent hindsight reconstruction of the present invention.

It is well settled that it is impermissible simply to engage in hindsight reconstruction of the claimed invention, using Applicant's structure as a template and selecting elements from the references to fill in the gaps. *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991). Recognizing, after the fact, that a modification of the prior art would provide an improvement or advantage, without suggestion thereof by the prior art, rather than dictating a

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conclusion of obviousness, is an indication of improper application of hindsight considerations. Simplicity and hindsight are not proper criteria for resolving obviousness. *In re Warner*, 397 F.2d 1011, 154 USPQ 173 (CCPA 1967).

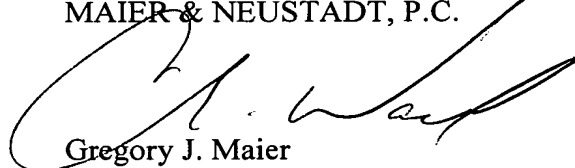
Accordingly, the Applicants respectfully request the withdrawal of the obviousness rejection of independent Claims 1, 8, and 20.

The dependent claims are considered allowable for the reasons advanced for the independent claims from which they depend. These claims are further considered allowable as they recite other features of the invention that are neither disclosed nor suggested by the applied references when those features are considered within the context of their respective independent claim.

Consequently, in view of the above discussion, it is respectfully submitted that the present application is in condition for formal allowance and an early and favorable reconsideration of this application is therefore requested.

Respectfully Submitted,

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